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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,640	08/07/2003	Takako Ozawa	Q76832	8806

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WASHINGTON, DC 20037

EXAMINER
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BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/635,640

Applicant(s)

OZAWA ET AL.

Examiner

Kevin M. Bernatz

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Examiner's Comments***

2. The Declaration of Masakazu Nishikawa has been received and given due consideration.
3. The Examiner respectfully recommends inserting a space between the numbers and the units in the pending claims for better readability/clarity, e.g. "0.3nm" should be "0.3 nm".

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 – 3, 6 – 8 and 11 – 13 are rejected under 35 U.S.C. 102(a) and/or (e) as being anticipated by Nakamikawa et al. (U.S. Patent App. No. 2003/0143432 A1).

The Examiner notes that, in addition to other possibilities, this reference can be overcome by the submission of a certified translation of applicants' priority document, thereby perfecting applicants' claim to priority under 35 U.S.C. 119(a) – (d).

Regarding claims 1 - 3, Nakamikawa et al. disclose a master information carrier having on a surface thereof an irregularity pattern representing information to be magnetically transferred to a magnetic recording medium held in contact with the surface of the master information carrier (*Figure 2B and relevant disclosure thereto*), wherein the parts of the surfaces of the master information carrier which are brought into contact with the magnetic recording medium meet applicants' claimed center plane mean surface roughness SRa limitations (*Paragraph 0019*).

Regarding claims 6 and 11, Nakamikawa et al. disclose substrates meeting applicants' claimed material and structural limitations (*Paragraph 0044 and examples*).

Regarding claims 7, 8, 12 and 13, Nakamikawa et al. disclose magnetic layers meeting applicants' claimed thickness limitations (*Paragraph 0046 and examples*).

### ***Claim Rejections - 35 USC § 103***

6. Claims 4, 5, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamikawa et al. as applied above, and further in view of Nishikawa et al. (U.S. Patent App. No. 2002/0034028 A1).

The Examiner notes that since this rejection is predicated upon art that qualifies under the "35 U.S.C. 102(a) standard" a statement under 35 U.S.C. 103(c) cannot overcome the above noted rejection.

Nakamikawa et al. is relied upon as described above.

Nakamikawa et al. fail to disclose depth of the irregularity pattern on the substrate.

However, Nishikawa et al. teach that in order to form a signal bearing pattern on a master medium, the irregularity pattern should be formed to depths meeting applicants' claimed limitations (*Paragraphs 0032 and 0035*).

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Nakamikawa et al. to utilize a depth of the irregularity patterns meeting applicants' claimed depth limitations as taught by Nishikawa et al. in order to form a signal bearing pattern on the master medium surface.

### ***Response to Arguments***

**7. The prior rejection of claims 1 - 13 under 35 U.S.C § 103(a) – Nishikawa in view of Nishikawa et al.**

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

The above noted rejection has been withdrawn in view of applicant(s) arguments, which have been found persuasive. Specifically, applicant(s) argue that the center plane mean surface roughness (SRa) is different than the average surface roughness

(Ra) taught by the prior art of record, which is deemed to not be anticipated, nor rendered obvious, by the above noted rejection. The Examiner notes that the declaration of Masakazu Nishikawa provides sufficient evidence that simply because a surface has an "average surface roughness" (Ra) in the claimed range that there is no reason to believe that the surface would inherently possess a center plane mean surface roughness (SRa) within the claimed range.

### ***Conclusion***

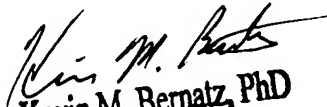
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tsubata et al. (U.S. Patent App. No. 2002/0098387 A1) teach a master information carrier similar structure to applicants' claimed structure, wherein the portions of the master medium which contacts the magnetic recording medium possesses an average surface roughness at the centerline ( $R_p$ ) overlapping applicants' claimed "magnitude" of SRa values. However, Tsubata et al. does not disclose controlling the center plane mean surface roughness (SRa) to within applicants' claimed limitations and there is no reason to believe that the  $R_p$  values will inherently be within the claimed SRa values.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB  
August 3, 2005

  
Kevin M. Bernatz, PhD  
Primary Examiner